



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/319,093	08/16/1999	MIN-JAE HAN	6715/57089	2372

7590 02/02/2004

JAY H MAIOLI  
COOPER & DUNHAM  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER
----------

HAYES, JOHN W

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/319,093

Applicant(s)

HAN, MIN-JAE

Examiner

John W Hayes

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 May 1999 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3621

## **DETAILED ACTION**

### ***Status of Claims***

1. Applicant has amended claims 1 and 11 in the amendment filed 03 November 2003 and previously canceled claims 19-45. Claims 1-18 remain pending and are again presented for examination.

### ***Response to Arguments***

2. Applicant's arguments filed 03 November 2003 have been fully considered but they are moot based on the new grounds of rejection.

### ***Claim Rejections - 35 U.S.C. ' 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatani (US PAT. 5,481,411) in view of Ball et al. (Ball hereinafter: EPO 0 309 298), Suzuki, U.S. Patent No 5,850,527 and Yoshioka, U.S. Patent No. 4,964,109.

Nakatani discloses a record/playback apparatus comprising:

a record/playback unit (Figs. 1, 5, 6, and 7) for reading out data from a first recording medium (e.g., master tapes) and recording the data onto a second recording medium (e.g., video, audio or computer soft ware tapes) according to different speeds (Col. 1, lines 18-55); and

Art Unit: 3621

a control unit (elements 6, 35, 70, 80, and 105) for controlling the record/playback unit to start the recording of data from the first medium to the second medium without transmitting data to a payment imposing unit.

**Re claim 1:** Nakatani does not explicitly disclose that (a) the control unit is for generating basic data for imposing payment from at least data indicative of a user identification and data indicative of a dubbing speed selected by the user for recording the data read out from the first recording medium onto the second recording medium at the dubbing speed selected by the user and transmitting the basic data, and when receiving data indicative of proper completion of imposing payment, directing the record/playback unit in response to the received data indicative of the proper completion of imposing payment to start the recording of the data read out from the first recording medium onto the second recording medium and (b) a payment imposing unit for determining, when receiving the basic data for imposing payment transmitted by the control unit, an amount of payment based on the dubbing speed selected by the user and imposing the amount of payment for a user specified the user identification and for transmitting to the control unit the data indicative of proper completion of imposing payment thereby verifying an electronic transfer of fund from an account of the user. However, Ball discloses the use of royalty encoding and accounting means (page 5, line 2) to insure the calculation and making of the appropriate royalty payments for the copying by the apparatus. Further, Ball discloses encoding the royalty information together with information identifying the machine, date, time, and the customer. Thus, it would have been within the level of ordinary skill in the art to modify the apparatus of Nakatani by adopting the teachings of Ball (i.e., using royalty encoding means and accounting means) to insure the calculation and making of the appropriate royalty payments for the copying by the apparatus. It is arguable that Ball does not explicitly disclose the royalty encoding means being located in the control unit. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the royalty encoding means at any desirable location including in the control unit as

Art Unit: 3621

claimed, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Further, it is arguable that Ball does not use data indicative of a speed for recording the data read out.

Suzuki discloses an information providing apparatus that enables user selected information to be recorded and also enables the user to select a speed at which the information is transmitted and recorded to a local terminal (Col. 9, lines 58-64; Col. 10, lines 8-43; Col. 14, lines 1-7 and 54-67) and further teaches wherein the payment imposed on the user is based on the transmission or recording speed selected by the user (Figures 13-14 and 17-18; Col. 6, lines 43-49 and 55-60; Col. 13, lines 24-48 and Col. 20, lines 30-35). Thus, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the methods of Nakatani and Ball and adopt the teachings of Suzuki and incorporate the ability to charge different fees based upon the recording speed. Suzuki provides motivation by indicating that this would provide more flexibility due to the fact that the user can be charged a fee based upon the quality and value of the information provided (Col. 5, lines 1-5; Col. 6, lines 55-60; Col. 20, lines 30-35).

Nakatani discloses a control unit, as shown above, that causes the record/playback unit to start the recording of data without transmitting data to a payment imposing unit. In Nakatani, the recording is not dependent upon any payment of fees, and therefore, the recording of data is started without transmitting any data to a payment imposing unit. Nakatani, however, fails to explicitly disclose a standard dubbing speed, but rather an "N" speed dubbing where "N" is greater than 1. Yoshioka discloses digital disc reproduction system and teaches a record/playback unit to read data from a first recording medium (Figure 2, CD Player 12) and record onto a second recording medium (Figure 2, cassette recorder 11). Yoshioka further teaches a control unit (microcomputer) for controlling the recording operation in fast speed dubbing mode as well as standard speed dubbing mode using a selector switch (Col. 5, lines 7-20). Yoshioka also teaches that the recording is started in the standard speed dubbing mode without transmitting any data to a payment imposing unit since Yoshioka is not

Art Unit: 3621

concerned with paying for the service. Thus, it would have been obvious to one having ordinary skill in the art to implement either scenario (payment required or no payment required) in the system of Nakatani in view of the teachings of Ball, Susuki and Yoshioka. If one was concerned about receiving payment for the dubbing service at increased speeds, then, it would have been obvious to one having ordinary skill in the art to modify Nakatani and adopt the teachings of Ball and Susuki to allow for charging based upon the dubbing speed. If one was not concerned about receiving payment or offering the service for free if the standard dubbing speed is used, then, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Nakatani and adopt the teachings of Yoshioak to allow for recording at a standard speed without transmitting data to a payment imposing unit, thereby, starting the recording without charging the user.

**Re claim 2:** Neither Nakatani nor Ball explicitly discloses the use of a key data generator for the payment imposing unit. However, Ball discloses the use of a communication link (page 5, lines 10) for automatic forwarding of the royalty fees involved in the operation of the apparatus. Thus, it would have been obvious to one of ordinary skill in the art to employ a key data generator for the payment imposing unit (i.e., accounting means) to generate key data for secure transmission of the completion of imposing payment over the communication link to the apparatus.

**Re claims 3, 4:** It is fundamental in the art to verify the key data transmitted through the communication link by collating with key data held by the apparatus to prevent fraud. Further, Ball discloses recording of the data onto the second recording medium based on the judging to discourage subsequent unauthorized copying from the dispensed tapes.

**Re claim 5:** It is fundamental in the art to transfer any information after authentication of the key to prevent fraud.

**Re claims 6, 7:** Neither Nakatani nor Ball explicitly discloses the various payment imposing method. However, there are various ways of calculating royalty fees and it would have been within the

Art Unit: 3621

level of ordinary skill in the art to employ various fee calculating schemes including the claimed schemes as desired.

**Re claim 8:** Nakatani in view of Ball further discloses an operating unit (i.e., royalty encoding means) connected to the control unit and a data storage unit (i.e., master tapes) where a plurality of data is stored, wherein the control unit reads out corresponding data from the data storage unit in response to indicator data supplied in response to an information input from the operating unit and directs the record/playback unit to record the data read out from the data storage unit onto the first recording medium.

**Re claim 9, 10:** Ball discloses various embodiments including the data storage unit and the payment imposing unit are connected via a communications line to the control unit (page 5, lines 10-23). Thus, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Nakatani by adopting the teaching of Ball to enhance the function of the claimed apparatus.

5. Claims 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball in view of Suzuki, U.S. Patent no. 5,850,527 and Yoshioka, U.S. Patent No. 4,964,109.

Page 2, lines 6-10 and page 3 lines 35-37 thereof, Ball discloses a record/playback method of reading out data from a first recording medium and recording the data onto a second recording medium with the use of an apparatus capable of reading out the data from the first recording medium and recording the data onto the second recording medium, the method comprising the steps of:

Art Unit: 3621

reading out corresponding data from a data storage unit where a plurality of data is stored and recording the data onto a second recording medium in response to indicator data received from an operating unit in an apparatus for reading out data from a first recording medium and recording the data onto a second recording medium (page 2, lines 6-10);

generating basic data for imposing payment based on data indicative of user identification (i.e., based on input identification, basic data should be generated to calculate an appropriate royalty);

transmitting the basic data for imposing payment from the apparatus to a payment imposing unit (i.e., after generating the basic data based on input identification, the basic data should be transferred to a payment imposing unit (i.e., accounting means) to calculate the appropriate royalty;

imposing payment according to the basic data for imposing payment received and generating data indicative of completion of imposing payment thereby verifying an electronic transfer of funds from an account of the specific user in the payment imposing unit (i.e., after calculating the appropriate royalty, the machine will require payment of the royalty);

transmitting the data indicative of the completion of imposing payment from the payment imposing unit to the apparatus (i.e., after the royalty is paid by a user, the data of the completion of payment should be transferred to the apparatus); and

directing the apparatus to start recording the data read out from the first recording medium onto the second recording medium in response to the data indicative of the completion of imposing payment (i.e., after receiving the data of the completion of payment from the payment imposing unit (i.e., accounting means), the apparatus would make a copy of selected music).

**Re claims 11:** Ball does not explicitly disclose that an amount of payment is determined according to the dubbing speed selected by the user for recording the data read out from the first recording medium onto the second recording medium and a payment amount for a user is determined according to the dubbing speed and data indicative of user identification.

Susuki discloses an information providing apparatus that enables a user select information to be recorded and also enables the user to select a speed at which the information is transmitted and recorded to a local terminal (Col. 9, lines 58-64; Col. 10, lines 8-43; Col. 14, lines 1-7 and 54-67) and further



Art Unit: 3621

teaches wherein the payment imposed on the user is based on the transmission or recording speed selected by the user (Figures 13-14 and 17-18; Col. 6, lines 43-49 and 55-60; Col. 13, lines 24-48 and Col. 20, lines 30-35). Thus, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the methods of Nakatani and Ball and adopt the teachings of Suzuki and incorporate the ability to charge different fees based upon the recording speed. Suzuki provides motivation by indicating that this would provide more flexibility due to the fact that the user can be charged a fee based upon the quality and value of the information provided (Col. 5, lines 1-5; Col. 6, lines 55-60; Col. 20, lines 30-35).

Ball further fails to explicitly disclose starting the recording at a standard dubbing speed without transmitting the basic data to a payment imposing unit. Yoshioka discloses digital disc reproduction system and teaches a record/playback unit to read data from a first recording medium (Figure 2, CD Player 12) and record onto a second recording medium (Figure 2, cassette recorder 11). Yoshioka further teaches a control unit (microcomputer) for controlling the recording operation in fast speed dubbing mode as well as standard speed dubbing mode using a selector switch (Col. 5, lines 7-20). Yoshioka also teaches that the recording is started in the standard speed dubbing mode without transmitting any data to a payment imposing unit since Yoshioka is not concerned with paying for the service. Thus, if one was not concerned about receiving payment or offering the service for free if the standard dubbing speed is used, then, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Ball and adopt the teachings of Yoshioak to allow for recording at a standard speed without transmitting data to a payment imposing unit, thereby, starting the recording without charging the user.

**Re claim 12:** Ball does not explicitly disclose the step of generating key data using the payment imposing unit as the data indicative of the completion of imposing payment from the basic data received. However, Ball discloses the use of a communication link (page 5, lines 10) for automatic forwarding of the royalty fees involved in the operation of the apparatus. Thus, it would have been obvious to one of

Art Unit: 3621

ordinary skill in the art to generate key data for secure transmission of the completion of imposing payment over the communication link to the apparatus.

**Re claims 13, 14:** It is fundamental in the art to verify the key data transmitted through the communication link by collating with key data held by the apparatus to prevent fraud. Further, Ball discloses recording of the data onto the second recording medium based on the judging to discourage subsequent unauthorized copying from the dispensed tapes.

**Re claim 15:** It is fundamental in the art to transfer any information after authentication of the key to prevent fraud.

**Re claim 16, 17:** Ball does not explicitly disclose the various payment imposing method. However, there are various ways of calculating royalty fees and it would have been within the level of ordinary skill in the art to employ various fee calculating schemes including the claimed schemes as desired.

**Re claim 18:** Ball discloses reading out corresponding data from a data storage unit in response to indicator data supplied from an operating unit (i.e., a customer selects musical pieces) and recorded onto the first recording medium (i.e., transferred to video disk) where the corresponding data corresponds to the indicator data (i.e., the data to be recorded is matched to the identification of the customer).

### ***Conclusion***

6 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3621

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Donovan et al. (US PAT. 6,012,032) are cited by the Examiner to support his position of billing the use of data access based on various factors including the speed.

Art Unit: 3621

8 Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

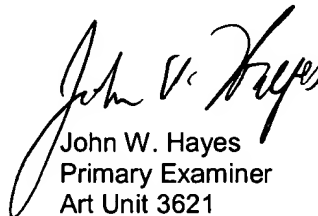
***Commissioner of Patents and Trademarks  
Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-5531** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,  
VA, 7<sup>th</sup> floor receptionist.

  
John W. Hayes  
Primary Examiner  
Art Unit 3621

January 25, 2004